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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,988	02/13/2001	Hitoshi Sekine	49986-0505	1948
29989	7590	03/11/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			EHICHIOYA, FRED I	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,988

Applicant(s)

SEKINE ET AL.

Examiner

Fred I. Ehichioya

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 4, 6 - 14, 16 - 24, and 26 - 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6 - 14, 16 - 24, and 26 - 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 06 December 2004, PROSECUTION IS HEREBY REOPENED. The rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. After an Appeal Conference, Conferees decided to withdraw the finality of the last Office Action and therefore, the finality of that action is withdrawn.

3. With respect to claims 1 – 4, 6 – 14, 16 – 24, and 26 - 31, detail action follows:

4. Applicants argue:

Ramsey and Moon do not teach or suggest a data storage apparatus that includes a data processor configured to "in response to processing the search query against the digital data stored on the WORM storage device, generate data that

identifies data stored on the WORM storage device that satisfies the search query"
Page 4, Para 2 of the arguments).

In response to Applicants' argument: Examiner respectfully disagrees with the applicant. Thiel teaches "in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query" as disclosed on pages 18 – 19, "WORM System" and page 21, paragraphs 4 and 5 "Top Functionality and Software".

5. In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Office Action.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1 – 3, 8 – 13, 18 – 23, 28 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,502,576 issued to Ramsay, Thomas E. et al. (hereinafter "Ramsay") in view of NPL "Integrated CD-ROM and WORM Optical Disk Systems on the Navy's Paperless Ship" by Thiel, Thomas J. (hereinafter "Thiel").

Regarding claims 1, 12 and 22, Ramsay teaches a data storage apparatus comprising:

an interface configured to receive digital data (see column 19, lines 64 – 67);
and a data processor communicatively coupled to the interface and being configured (see column 27, lines 40 – 43 and lines 64 – 67) to:

automatically receive digital data from the interface and cause the digital data to be stored to a write-once-read-many (WORM) storage device (see column 6, lines 27 – 30, column 30, lines 22 - 24 and column 31, lines 24 – 33),

Ramsay does not explicitly teach process a search query against the digital data stored on the WORM storage device, and in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query.

However, Thiel teaches process a search query against the digital data stored on the WORM storage device (see pages 18 – 19, "WORM System" and page 21, paragraphs 4 and 5 "Top Functionality and Software"), and

in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query (see pages 18 – 19, "WORM System" and page 21, paragraphs 4 - 6 "Top Functionality and Software").

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Thiel's teaching of "in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query" would have led Ramsay's system toward a paperless environment and improve the management of information as suggested by Thiel (see Abstract).

Regarding claim 2, Ramsay teaches a WORM storage device (see column 30, lines 22 – 24).

Regarding claims 3, 13 and 23, Thiel teaches the data processor is further configured to generate one or more indexes for data stored to the WORM storage device (see page 18, paragraph 6).

Regarding claims 8, 18 and 28, Ramsay teaches the digital data includes facsimile data (see column 21, lines 44 – 45).

Regarding claims 9, 19 and 29, Ramsay teaches the digital data includes electronic document data (see column 29, line 53).

Regarding claims 10, 20 and 30, Ramsay teaches the digital data includes printer data (see column 25, lines 39 – 44).

Regarding claims 11, 21 and 31, Ramsay teaches the data is stored on an WORM optical medium (see column 30, lines 22 – 24), and

the data processor is further configured to cause a label to be applied to the WORM optical medium, wherein the label specifies one or more attributes of the data (see column 14, line 64; column 30, lines 23 – 24 and lines 58 – 62).

8. Claims 4, 6, 7, 14, 16, 17, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsay in view of Thiel and further in view U.S. Patent 6,202,124 issued to Kern Robert Frederick (hereinafter "Kern").

Regarding claims 4, 14 and 24, Ramsay or Moon does not explicitly teach "meta data".

Kern teaches the data processor is further configured to generate meta data that describes one or more attributes of the data stored to the WORM storage device (see column 3, lines 20 – 23 and column 7, lines 1 – 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching Kern with the teaching of Ramsay and Moon wherein processor is further configured to generate Meta data that describes one or more attributes of the data stored to the WORM. The motivation is that the Meta data contain definitions and versions of the digital data stored on the WORM.

Regarding claims 6, 16 and 26, Kern teaches the data processor is further configured to process the search query against one or more indexes generated by the data processor (see column 6, lines 48 – 52).

Regarding claims 7, 17 and 27, Kern teaches the data processor is further configured to automatically process the search query according to a set of one or more time criteria (see column 6, lines 48 – 56 and column 8, lines 16 - 20).

Conclusion


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

February 28, 2005


SHAHID ALAM
PRIMARY EXAMINER